



3510-16-P

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Patent Review and Derivation Proceedings

ACTION: Proposed collection; comment request.

SUMMARY: The United States Patent and Trademark Office (USPTO), as required by the Paperwork Reduction Act of 1995 invites comments on a proposed extension of an existing information collection: 0651-0069 (Patent Review and Derivation Proceedings).

DATES: Written comments must be submitted on or before [INSERT DATE 60 DAYS AFTER THE DATE OF PUBLICATION IN THE FEDERAL REGISTER].

ADDRESSES: You may submit comments by any of the following methods:

- *Email:* InformationCollection@uspto.gov. Include “0651-0069 comment” in the subject line of the message.
- *Federal Rulemaking Portal:* <http://www.regulations.gov>.
- *Mail:* Michael P. Tierney, Records and Information Governance Division Director, Office of the Chief Technology Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.

FOR FURTHER INFORMATION CONTACT: Requests for additional information should be directed to Michael P. Tierney, Vice Chief Administrative Patent Judge, Patent Trial

and Appeal Board, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450; by telephone at 571-272-4676; or by email to Michael.Tierney@uspto.gov with “0651-0069 comment” in the subject line. Additional information about this collection is also available at <http://www.reginfo.gov> under “Information Collection Review.”

SUPPLEMENTARY INFORMATION:

I. Abstract

The Leahy-Smith America Invents Act, which was enacted into law on September 16, 2011, provided for many changes to the procedures of the Patent Trial and Appeal Board (“PTAB” or “Board”, formerly the Board of Patent Appeals and Interferences) procedures. These changes included the introduction of *inter partes* review, post-grant review, derivation proceedings, and the transitional program for covered business method patents. Under these administrative trial proceedings, third parties may file a petition with the PTAB challenging the validity of issued patents, with each proceeding having different requirements regarding timing restrictions, grounds for challenging validity, and who may request review.

Inter partes review is a trial proceeding conducted at the Board to review the patentability of one or more claims in a patent only on a ground that could be raised under §§ 102 or 103, and only on the basis of prior art consisting of patents or printed publications. Post grant review is a trial proceeding conducted at the Board to review the patentability of one or more claims in a patent on any ground that could be raised under § 282(b)(2) or (3). A derivation proceeding is a trial proceeding conducted at the Board to determine whether (1) an inventor named in an earlier application derived the

claimed invention from an inventor named in the petitioner's application, and (2) the earlier application claiming such invention was filed without authorization. The transitional program for covered business method patents is a trial proceeding conducted at the Board to review the patentability of one or more claims in a covered business method patent.

This collection covers information submitted by the public to petition the Board to initiate an *inter partes* review, post-grant review, derivation proceeding, and the transitional program for covered business method patents, as well as any responses to such petitions, and the filing of any motions, replies, oppositions, and other actions, after a review/proceeding has been instituted.

II. Method of Collection

Electronically, if applicants submit the information using the PTAB End-to-End (PTAB E2E). Applicants may submit information via email if PTAB E2E is unavailable.

III. Data

OMB Number: 0651-0069.

IC Instruments and Forms: N/A.

Type of Review: Extension of an existing information collection.

Affected Public: Business or other for-profit organizations; individuals or households; not-for-profit institutions; Federal Government; and state, local, or tribal governments.

Estimated Number of Respondents: 11,994 responses per year.

Estimated Time per Response: The USPTO estimates that it will take the public between an estimated 6 minutes (0.10 hours) to 165.30 hours to complete an individual form in this collection.

Estimated Total Annual Respondent Burden Hours: 1,474,449 hours.

Estimated Total Annual Respondent (Hourly) Cost Burden: \$645,808,793. The USPTO expects that attorneys will complete the instruments associated with this information collection. The professional hourly rate for intellectual property attorneys in private firms is \$438 as established by estimates in the 2017 Report of the Economic Survey, published by the Committee on Economics of Legal Practice of the American Intellectual Property Law Association. Using this hourly rate, the USPTO estimates that the total respondent cost burden for this collection is \$645,808,793 per year.

IC Number	Item	Estimated Response Time (Hours) (a)	Estimated Responses (b)	Estimated Burden Hours (c) (a) x (b)	Rate (d)	Estimated Cost Burden (e) (c) x (d)
1	Petition for <i>Inter Partes</i> Review	124	1,553	192,572.00	\$438.00	\$84,346,536.00
2	Petition for Post-Grant Review or Covered Business Method Patent Review	165.30	91	15,042.30	\$438.00	\$6,588,527.40
3	Petition for Derivation	165.30	11	1,818.30	\$438.00	\$796,415.40
4	Patent Owner Preliminary Response to Petition for Initial <i>Inter Partes</i> Review	91.60	1,333	122,102.80	\$438.00	\$53,481,026.40
5	Patent Owner Preliminary Response to Petition for Initial Post-Grant Review or Covered Business Method Patent Review	91.60	68	6,228.80	\$438.00	\$2,728,214.40
6	Request for Rehearing	80	322	25,760.00	\$438.00	\$11,282,880.00
7	Motions, Replies, and Oppositions After Institution in <i>Inter Partes</i> Review	158	6,482	1,024,156.00	\$438.00	\$448,580,328.00
8	Motions, Replies, and Oppositions After Institution in Post-Grant Review or Covered Business Method Review	148	245	36,260.00	\$438.00	\$15,881,880.00
9	Motions, Replies, and Oppositions After Institution in Derivation Proceedings	120	7	840.00	\$438.00	\$367,920.00
10	Request for Oral Hearing	18.30	727	13,304.10	\$438.00	\$5,827,195.80
11	Request to Treat a Settlement as Business Confidential	2	356	712.00	\$438.00	\$311,856.00
12	Settlement	100	356	35,600.00	\$438.00	\$15,592,800.00
13	Arbitration Agreement and Award	4	2	8.00	\$438.00	\$3,504.00

14	Request to Make a Settlement Agreement Available	1	1	1.00	\$438.00	\$438.00
15	Notice of Judicial Review of a Board Decision (e.g. Notice of Appeal Under 35 U.S.C. §142)	0.10	440	44.00	\$438.00	\$19,272.00
	Total		11,994	1,474,449.30		\$645,808,793.40

Estimated Total Annual (Non-hour) Respondent Cost Burden: \$54,307,175. There are no capital start-up, maintenance, or postage associated with this information collection. However, this collection does have annual (non-hour) costs in the form of filing fees.

Filing Fees

The filing fees associated with this information collection are listed in the table below:

IC Number	Item	Responses (a)	Filing Fees (b)	Total Cost (c) (a) x (b)
1	<i>Inter Partes</i> Review Request Fee	1,560	\$15,500.00	\$24,180,000.00
1	<i>Inter Partes</i> Post-Institution Fee	1,569	\$15,000.00	\$23,535,000.00
1	<i>Inter Partes</i> Review Request of Each Claim in Excess of 20	3,390	\$300.00	\$1,017,000.00
1	<i>Inter Partes</i> Post-Institution Request of Each Claim in Excess of 15	1,786	\$600.00	\$1,071,600.00
2	Post-Grant or Covered Business Method Review Request Fee – Up to 20 Claims	92	\$16,000.00	\$1,472,000.00
2	Post-Grant or Covered Business Method Review Post-Institution Fee – Up to 15 Claims	92	\$22,000.00	\$2,024,000.00
2	Post-Grant or Covered Business Method Review Request of Each Claim in Excess of 20	638	\$375.00	\$239,250.00
2	Post-Grant or Covered Business Method Review Post-Institution Fee of Each Claim in Excess of 15	925	\$825.00	\$763,125.00
3	Petition for Derivation	12	\$400.00	\$4,800.00
14	Request to Make a Settlement Agreement Available	1	\$400.00	\$400.00
	Total			\$54,307,175.00

IV. Request for Comments

Comments submitted in response to this notice will be summarized or included in the request for OMB approval of this information collection. They also will become a matter of public record.

Comments are invited on:

- a) Whether the proposed collection of information is necessary for the proper performance of the functions of the agency, including whether the information shall have practical utility;
- b) The accuracy of the agency's estimate of the burden (including hours and cost) of the proposed collection of information;
- c) Ways to enhance the quality, utility, and clarity of the information to be collected; and
- d) Ways to minimize the burden of the collection of information on respondents, e.g., the use of automated collection techniques or other forms of information technology.

Marcie Lovett,

Records and Information Governance Division Director, OCTO

United States Patent and Trademark Office. ,

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